

Arguments/Remarks

Claims 23-24, 33-40, and 43 are currently pending. Claims 23-24 have been amended to more clearly define the invention. Claim 43 has been added. None of the amendments or additional claims constitute new matter.

Rejections Under 35 U.S.C. 112

The claims 34-42 have been rejected under 35 U.S.C. 112, first paragraph as not being enabled by the specification. More particularly, the Examiner states with regard to claim 34, that the specification does not enable a composition comprising a therapeutically effective amount of a compound of formula (I) and a "further drug substance" because the claim includes therapeutic agents that are known and those that may be discovered in the future, for which there is no enablement. Applicants have limited the claim to known therapeutics, and the rejection is respectfully traversed.

The Examiner has also rejected claims 35-42 as being 'reach through' claims (See page 4 of the office action, line 3, first paragraph). A reach-through claim attempts to cover antagonists beyond the scope of the disclosure. A reach-through claim in the present application, for example, would attempt to cover all small molecule inhibitors of the particular target.

The present claims are however limited to those compounds disclosed and claimed in the present application. Claims 35-36, and 40 (and those dependant therefrom) for example, are directed to method of treating disease comprising, "administering an effective amount of a compound according to claim 23." The claims are not "reach through" claims. Compounds of formula (I) according to claim 1 are clearly disclosed and enabled in the specification. The Examiner also rejects the use of the term "preventing," which has been deleted. Withdrawal and reconsideration of the rejections are respectfully requested.

The Examiner has also rejected claims 23-42 as being indefinite for failing to point out and distinctly claim the subject matter which applicants regard as their invention. More particularly, the Examiner objects to the use of the term "comprising" throughout the claims.

The requirement that the claims particularly point out and distinctly claim the invention is met when a person of skill in the art of the invention would understand the scope of the subject matter claimed in light of the specification. It is noted the Examiner has correctly indicated that the term, "comprising" is an open-ended term, which leaves the claim open for inclusion of unspecified groups and substitutions. The term "Comprising" therefore is well understood by the Examiner and correctly defines applicants invention throughout the specification and the claims. It is unclear why the Examiner would object to such a well-defined term as being unclear. Withdrawal and reconsideration are requested.

The rejection of the definition of variable A, and the term "of formula" (in claim 31) is also noted. Applicants have amended the claims so that A is only C, and have canceled claim 31 in order to traverse the rejections. Reconsideration and withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. 102 and 103

The Examiner has rejected claims 23-30, and 32-42 under 35 U.S.C. 102(b) as anticipated and under 103 as being obvious over WO 01/64654 to Pease, et al. In light of Applicants' amendments to claims 23 and 24, the presently claimed invention is novel and unobvious over the cited art. Withdrawal and reconsideration of the rejections is respectfully requested.

The Examiner has also rejected claims 23-42 under 35 U.S.C. 103(a) as being obvious over WO03/078404 to Baenteli, et al.

In applying the test for obviousness to chemically similar structures, the Court of Appeals Federal Circuit recently laid out a standard in *Takeda Chemical Industries Ltd. v. Alphapharm Pty. Ltd*, 83 USPQ2d 1169 (Fed. Cir. 2007). The Court stated, "in many cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish a prima facie case of obviousness. ... in order to find a prima facie case of obviousness (for structurally related compounds), a showing that the 'prior art would have suggested making the specific molecular modifications necessary to achieve the claimed invention' was also necessary."

In the present case, the Examiner has not identified a reason to modify the compounds of Baenteli to arrive at the presently claimed invention. Absence such motivation, the Examiner has not made a prima facie case of obviousness. Withdrawal and reconsideration are respectfully requested.

Double Patenting Rejection

The Examiner has rejected claims 1-11 and 13-22 provisionally on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 4, and 7-9 of copending application No. 10/507,060, and 10/549,250. Upon indication of allowable subject matter, applicants will appropriately address the double patenting rejection.

Should the Examiner have any questions, please contact the undersigned attorney.

Respectfully submitted,



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